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10/735,203	12/12/2003	Lawrence W. Cosenza	DSI-10402/22	2593

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08/24/2009

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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

ATTACHMENT TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

10. CONT. The previous Notice mailed to appellant on 5/1/09 stated that the appellant cites numerous references in their argument section which are not listed in the evidence section and for which no copies have been provided as required. MPEP 1205.02 specifically states, “[i]f in his or her brief, appellant relies on some reference, he or she is expected to provide the Board with a copy of it in the evidence appendix of the brief”. Some of the references cited in the arguments section are indicated as “incorporated by reference” in the specification. However, unless copies of such references have been specifically provided to the office in an IDS or provided elsewhere as evidence, they are not considered to be of record in the instant application. Other references have simply been cited without any indication whether they are new or have been previously submitted in the IDS of 5/4/05. The appellant was also reminded that **reference to unentered evidence is not permitted in an appeal brief. MPEP 1205.02 (ix)**. In particular, the appellant cites Hagar et al. (1997) Nature, V. 385, 823-826 which has never been previously discussed and is **not of record**, and Lugli et al. which is **not of record**. In regards to Lugli et al., the Notice mailed on 5/1/09 pointed out that this reference has never been provided for the examiner's consideration or been made of record. The appellant first referred to this publication in their remarks submitted on 3/6/07 in response to the non-final action of 12/8/06. In the Final office action mailed 8/24/07, the examiner indicated that the Lugli reference was **not** considered as it had not been provided or made of record. The appellants referred again to the Lugli reference in their amendment after final rejection submitted on 12/21/07. In the Advisory Action

mailed on 2/29/08, the examiner points out that the Lugli reference is still not of record.

Therefore, the appellant may not rely on the Lugli et al. reference in their Appeal Brief.

In response to the Notice of 5/1/09, the appellant has submitted a “corrected” appeal brief. The only change to the Brief appears to be changing Appendix B, the evidence section, to state that no evidence is present in the Brief. However, the arguments section continues to argue and rely on numerous publications as evidence in support of their positions. Thus, the appendix is incorrect. On pages 9-10 of the corrected brief, the appellant continues to cite from and provide arguments based on the Lugli et al. reference, which as discussed in detail above and in previous communications is not of record. Page 14 continues to cite from and provide arguments based on Hager et al., which is also not of record. Pages 13-14 and 16 also continue to cite a number of additional references identified as “incorporated by reference”. However, as previously noted, it does not appear that copies of these references were provided in an IDS or some other communication from the appellants, and therefore have never been previously considered or entered by the examiner. Again, as set forth in MPEP 1205.02, “[i]f in his or her brief, appellant relies on some reference, he or she is expected to provide the Board with a copy of it in the evidence appendix of the brief”. MPEP 1205.02 also states in relation to specific items required by 37 CFR 41.37(c)(1) that the brief must contain “[a]n appendix containing copies of any evidence submitted pursuant to 37 CFR 1.130, 1.131, or 1.132, or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See 37 CFR 41.33 for treatment of evidence submitted after appeal”.

Therefore, for the reasons set forth above, the appeal brief does not comply with 37 CFR 41.37.

Any inquiry concerning this communication from the examiner should be directed to Anne Marie S. Wehbé, Ph.D., whose telephone number is (571) 272-0737. If the examiner is not available, the examiner's supervisor, Joseph Woitach, can be reached at (571) 272-0739. For all official communications, the technology center fax number is (571) 273-8300. Please note that all official communications and responses sent by fax must be directed to the technology center fax number. For informal, non-official communications only, the examiner's direct fax number is (571) 273-0737. For any inquiry of a general nature, please call (571) 272-0547.

The applicant can also consult the USPTO's Patent Application Information Retrieval system (PAIR) on the internet for patent application status and history information, and for electronic images of applications. For questions or problems related to PAIR, please call the USPTO Patent Electronic Business Center (Patent EBC) toll free at 1-866-217-9197. Representatives are available daily from 6am to midnight (EST). When calling please have your application serial number or patent number available. For all other customer support, please call the USPTO call center (UCC) at 1-800-786-9199.

Dr. A.M.S. Wehbé

/Anne Marie S. Wehbé/
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